

REMARKS

Summary of the Final Office Action

Claims 11-19 stand withdrawn from consideration as being directed to a non-elected invention.

Claims 1-9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 6,626,294 to Fujishima et al. (“*Fujishima*”) in view of Japanese Publication JP-A-10-009235 (“*Japan '235*”), Japanese Publication JP-A-165256 (“*Japan '256*”), and Japanese Publication JP-A-199123 (“*Japan '123*”).

Claims 1-9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Japan '235* in view of *Japan '256* and *Japan '123* and further in view of *Fujishima*.

Summary of the Response to the Final Office Action

Claims 11-19 have been withdrawn. Claims 1-9 and 11-19 are pending with claims 1-9 under consideration.

The Rejections under 35 U.S.C. § 103(a)

(i) *Fujishima, Japan '235, Japan '256, and Japan '123*

Claims 1-9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Fujishima* in view of *Japan '235*, *Japan '256*, and *Japan '123*. Applicant respectfully traverses the rejections for at least the following reasons.

With respect to independent claim 1, Applicant respectfully submits that the applied references fail to disclose the features “the number of staples are wound in a roll-like shape” and “the tearable film is disposed on a side of the staples remote from the center of the roll-like

shape.” On page 3, the Office Action alleges that Figure 6 of *Fujishima* discloses this feature. Applicant respectfully disagrees. Applicant assumes the Final Office Action alleges pulling out tape 12 of *Fujishima* is a tearable film as claimed. Applicant respectfully disagrees. Independent claim 1 recites a combination wherein “the number of staple members are connected by adhering with the tearable film.” In *Fujishima*, staples 10a are not connected by adhering with pulling out tape 12. In fact, pulling out tape 12 is wound only one round on the roll staple body. *Fujishima*, col. 2, ll. 21-23. Instead, the function of the pulling out tape 12 is to provide a means by which the leading end portion of the roll staple body 11 can be extended in a sheet shape. *Fujishima*, col. 3, l. 65 – col. 4, l. 10. Accordingly, pulling out tape 12 is not a tearable film as claimed.

(ii) Japan '235, Japan '256, Japan '123, and Fujishima

Claims 1-9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Japan '235* in view of *Japan '256* and *Japan '123* and further in view of *Fujishima*. Applicant respectfully traverses the rejections for at least the following reasons.

With respect to independent claim 1, Applicant respectfully submits that the applied references fail to disclose the features “the number of staples are wound in a roll-like shape” and “the tearable film is disposed on a side of the staples remote from the center of the roll-like shape.” On page 4, the Office Action admits that *Japan '235* fails to disclose this feature. Instead, the Office Action relies on *Fujishima* to remedy this deficiency. (“*Fujishima '294* discloses that it’s well known to roll with film to the outside of roll.”). For the reasons set forth above, Applicant submits that the Office Action’s reliance on *Fujishima* is improper. Further,

the Office Action alleges, “One of ordinary skill in the art would recognize that both roll directions are well known in the art as generally equivalent for purpose of rolling whereby choice of either direction would have been an obvious design choice or engineering expedient for one of ordinary skill in the art as an aesthetic choice or to meet other objective of machine etc., not affecting the staples and film specifically.” Applicant respectfully disagrees. The location of the tearable film on the roll is not a mere matter of design choice. Rather, the location possesses certain advantages. The location of the tearable film on the roll dictates the location of the film relative to the staple and the sheets of paper after the sheets of paper have been bound by the staple. Specifically, locating the tearable film between the crown portion of the staple and the sheets of paper (by locating the tearable film on the outside of the roll) yields the following advantages. First, the film is not visible when sheets of paper are bound by the staple. Second, the film is not easily removed from the staple when sheets of paper are bound by the staple. Thus, the film is less likely to become adhered to the sheets of paper. Finally, the film is less likely to be removed within an electric stapler if a driver contacts the film when the staple is struck out by the driver. *See* Fig. 2. Thus, it is less likely defective operation of an electric stapler will result. Thus, Applicant respectfully asserts that the claimed configuration is novel and not merely an obvious matter of design choice. *See generally* MPEP § 716.02(f).

For at least the above reasons, Applicant requests that the rejection of claim 1 under 35 U.S.C. § 103(a) be withdrawn. Further, Applicant submits that claims 2-9 are allowable at least because of their respective dependencies from independent claim 1 and the reasons set forth above.

CONCLUSION

In view of the foregoing, Applicant respectfully requests entry of the amendments to place the application in clear condition for allowance or, in the alternative, in better form for appeal.

If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,
MORGAN, LEWIS & BOCKIUS LLP

Dated: November 16, 2009

By: \Mary Jane Boswell\
Mary Jane Boswell
Registration No. 33,652

CUSTOMER NO. 009629
MORGAN, LEWIS & BOCKIUS LLP
1111 Pennsylvania Avenue, N.W.
Washington, D.C. 20004
202.739.3000